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EXAMINER

ADDIE, RAYMOND W

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/636,057	Applicant(s) BOUDREAU, GUY	
	Examiner Raymond W. Addie	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 6-8 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 9-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 9-12 are drawn to a method of installing a sewer requiring compaction and excavation of a granular material. Whereas the originally filed claims 1-5 were only drawn to the apparatus of a self-leveling manhole assembly.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, Ins. 6-7 recite "the horizontal wall...transmits the forces applied thereto", but does not define what forces are being applied and to what the forces are transmitted to.

For Examination: The limitation is seen to require the horizontal wall be capable of transmitting any applied force to the substrate supporting the horizontal wall.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller # 1,033,448.

Mueller discloses a self-leveling gully-hole system (10) comprising:

A frame (10) having upper (11) and lower (13/14) portions.

A tubular section (16) having an upper end (15) is engaged inside the lower portion (13/14) of the frame (10).

Said lower portion (13/14) further comprising an inclined wall extending between points (13 and 14), which is capable of permitting positioning of said lower portion (13/14) at an angle relative to the axis of the tubular section (16) in order to follow the slope of the substrate.

Wherein the upper portion (11) has a horizontal wall (see Fig. 1), supported by upon a substrate and capable of transmitting forces applied thereto to the substrate. Further wherein the frame (10) is capable of displacing vertically and angularly by sliding along an external wall of the tubular section (16). See pages 12.

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In regards to Claim 7 Mueller discloses the upper portion (12) includes an inclined portion extending between points (12 and 13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ann'es # 6,109,824 in view of Finnegan # 81,266.

Ann'es discloses a self-leveling manhole system that serves to prevent damage to the surrounding roadway from applied traffic loads, said manhole system comprising:

A tubular section (6).

A frame assembly (3) having upper and lower apertures (1, 9) for transmitting surface water away from a road surface. Said apertures being eccentrically aligned in a vertical direction. The frame further comprising:

Upper and lower portions (2/35) and (5) respectively, the upper portion (2) further comprising:

Horizontal walls (26, 27) for supporting said frame upon a support surface such as a sub-base or ground (80), such that applied traffic loads are transmitted to the sub-base or ground.

And downwardly inclined interior walls (37, 38).

Wherein said frame (3) is capable of vertical and angular movement.

Said lower portion having a support flange (54), capable of being supported by a substrate. And inclined wall sections (50). See col. 3, ln. 33-col. 4, ln. 41.

What Ann'es does not disclose is the tubular section (6) being disposed within the lower portion (5) of the frame.

However, Finnegan teaches it is desirable to appropriately size a lower portion (b) of a manhole frame such that it "to slip easily over the upper end of pipe (a)", such as a manhole pipe, in order to dispose a support flange (c) within a substrate, such as the ground or a roadway sub-base, in order to accommodate changes in the earth, such as freeze and thaw related heave. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to size the lower portion (5) of the manhole frame of Ann'es, to easily slip over a manhole pipe, as taught by Finnegan, in order to accommodate weather related heave between the lower frame section and a relatively immobile manhole pipe.

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ann'es # 6,109,824 in view of Soderstrom # 4,255,909.

Ann'es discloses a self-leveling manhole system that serves to prevent damage to the surrounding roadway from applied traffic loads, said manhole system comprising:

A tubular section (6).

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A frame assembly (3) having upper and lower apertures (1, 9) for transmitting surface water away from a road surface. Said apertures being eccentrically aligned in a vertical direction. The frame further comprising:

Upper and lower portions (2/35) and (5) respectively, the upper portion (2) further comprising:

Horizontal walls (26, 27) for supporting said frame upon a support surface such as a sub-base or ground (80), such that applied traffic loads are transmitted to the sub-base or ground.

And downwardly inclined interior walls (37, 38).

Wherein said frame (3) is capable of vertical and angular movement.

Said lower portion having a support flange (54), capable of being supported by a substrate. And inclined wall sections (50). See col. 3, ln. 33-col. 4, ln. 41.

What Ann'es does not disclose is the tubular section (6) being disposed within the lower portion (5) of the frame.

However, Soderstrom teaches a manhold of the self-leveling/telescopic type. Said manhold having a frame assembly (9) comprising upper (12) and lower (10) portions. Both portions (10, 12) having unloading rings in the form of horizontal walls such that upper and lower portions are permitted relative vertical motion to accommodate weather related heave. Said lower frame assembly (10) being sized to fit over and around an external wall of a manhole pipe, in order to accommodate weather related soil heave,

between the lower frame portion (10) and a relatively immobile manhole pipe (unnumbered). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to size the lower frame portion of Ann'es to fit over and around an external wall of a manhole pipe, as taught by Soderstrom, in order to accommodate frost related heave between a lower portion of a manhole frame and a manhole pipe. See Soderstrom Col. 2, Ins. 23-42; col. 3, Ins. 14-24.

6. Applicant's arguments, see pages 5-7, filed 9/23/04, with respect to the rejection(s) of claim(s) 1-5 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mueller '448; Ann'es '824 in view of Finnegan '266; Ann'es in view of Soderstrom, respectively.

Applicant states "the Examiner's reference to upper portion of the frame by reference character '2/35' is not understood.

To that affect, reference characters in the form of (A/B) is an explicit indication of all the elements comprising the disclosed element of the cited prior art. Which is used throughout the rejections.

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Applicant argues against the disclosure of Ann'es by stating "according to Ann'es, has a tubular downwardly extending conduit (9), which as described in the patent...is integrally formed with the frame (3)...in addition, the lower portion (9) does not include any inclined wall.

However, it is unclear as to which claim(s) Applicant is referring to. Is Applicant referring to old claims 1-5 or new claims 6-8?

Applicant is reminded that since all original claims have been canceled, without prejudice, in favor of New Claims 6-8; the Examiner has withdrawn the 35 U.S.C. 102(b) rejection, cited in the Last Office Action, and put forth a New Grounds of Rejection including new prior art, and a 35 U.S.C. 103(a) based on Ann'es in view of Finnegan as well as Soderstrom. Hence,

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant then argues in favor of Claim 6 by stating "a self-leveling system comprises a tubular section and a frame having an upper and a lower portion...The frame...is capable of sliding along an external wall of the tubular section...Thus, the frame of

the invention adjusts itself naturally upon movement of the ground, while the tubular section does not move... This feature of the Applicant's system is not found in the system disclosed in Ann'es.

Applicant is reminded original Claim 1 only required "said frame to be capable of sliding the length of external wall of the tubular section"; whereas NEW CLAIM 6 now requires the frame to be "capable of sliding along an external wall of the tubular section.

To that extent, Ann'es discloses the claimed invention, to include lower support ring (54), but does not disclose the orientation between the lower frame portion and the manhole pipe. Further both Finnegan and Soderstrom teach the desirability of sizing the lower portion of a manhole frame to fit over and around a manhole pipe, in order to accommodate vertical sliding of the lower frame portion "along an external wall" of a tubular section, such that a support ring mounted on a periphery of the lower frame portion is supported by a substrate.

Therefore, the argument is not persuasive as it would pertain to the New Grounds of Rejection put forth above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shearer, Sr. # 2,791,792 discloses a gully-hole assembly. Dorr # 599,441 discloses a vertically adjustable manhole assembly.

Tomek # 2,254,668 discloses an expansion manhole top. Firchau et al. # 4,350,177 discloses a utility box support. Martin, Jr. et al. # 5,769,565 discloses a protective housing for sewer lines. Sharp # 5,117,877 discloses an overflow assembly for underground manhole assemblies. Kilman et al. # 5,525,006 discloses a flush mount well protector.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2PM, 6-8PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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RWA
21/1/04